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37274

PTO/SB/17 (10-03)

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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 130.00

## Complete if Known

Application Number	09/992,328
Filing Date	November 19, 2001
First Named Inventor	Bryan Bergeron
Examiner Name	Stephen J. Castellano
Art Unit	3727
Attorney Docket No.	7436-1

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number: 502346  
Deposit Account Name: Wyatt, Tarrant & Combs

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments

☐ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$ )

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below		Fee Paid
Total Claims	<input type="text"/>	-20** =	<input type="text"/>	X	<input type="text"/>	= <input type="text"/>
Independent Claims	<input type="text"/>	- 3** =	<input type="text"/>	X	<input type="text"/>	= <input type="text"/>
Multiple Dependent					<input type="text"/>	= <input type="text"/>

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$ )

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	130
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ ) 130.00

## SUBMITTED BY

Name (Print/Type)	Shawn D. Sentilles	Registration No. (Attorney/Agent)	38,299	Telephone	901-537-2192
Signature		Date	Jan. 16, 2004		

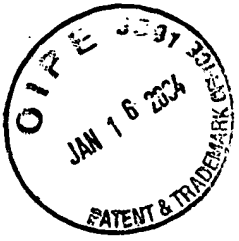
**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

APPLICANT: Bryan Bergeron

ATTY DOC #: 7436-1 (formerly 8100.01)

SERIAL NO.: 09/992,328

ART UNIT: 3727

FILING DATE: November 19, 2001

EXAMINER: Stephen J. Castellano

TITLE: "Drinking Container"

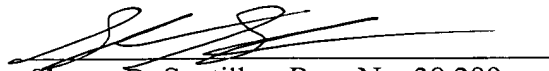
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**EXPRESS MAIL CERTIFICATE**

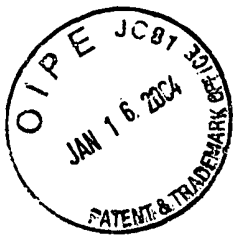
I hereby certify that the following papers or fees (along with any referred to as being attached or enclosed) are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date shown below in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

1. Fee Transmittal for FY 2004;
2. Petition For Reconsideration of Whether Applicant's Brief Complies with 37 CFR 1.192; and
3. Return Receipt Post Card.

  
Shawn D. Sentilles, Reg. No. 38,299  
WYATT, TARRANT & COMBS, LLP  
1715 Aaron Brenner Drive, Suite 800  
Memphis, TN 38120-4367  
901-537-2192

Date: January 16, 2004

Express Mail No. EV224466702US



IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

APPLICANT: Bryan Bergeron

ATTY DOC#: 7436-1 (formerly 8100.01)

SERIAL No.: 09/992,328

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EXAMINER: Stephen J. Castellano

TITLE: "Drinking Container"

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Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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JAN 23 2004  
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**PETITION FOR RECONSIDERATION OF WHETHER APPLICANT'S BRIEF  
COMPLIES WITH 37 CFR 1.192**

Dear Commissioner:

This petition relates to the January 5, 2004 Notification of Non-Compliance concerning applicant's appeal brief (Paper No. 21, attached hereto as Exhibit A). The primary issue is whether the Examiner is correct in taking the position that "Issues 1-3 of the appeal brief pertain to petitionable matters rather than appealable matters and should not appear in an appeal brief." A petition was necessary on this issue, and applicant contemporaneously seeks review of the remaining issues that have been raised in the Notification of Non-Compliance.

**Petition Issue 1: Whether Issues 1-3 of applicant's appeal brief should be resolved by appeal or by petition**

Applicant incorporates herein by reference the arguments set forth in his appeal brief concerning appeal issues 1-3 (attached hereto as Exhibit B), the Commissioner's

EXPRESS MAIL EV224466702US

November 18, 2002 decision on applicant's petition (Paper No. 12, attached hereto as Exhibit C), and the arguments set forth his prior petition concerning the drawings (attached hereto as Exhibit D).

The three issues in question are:

Issue 1 – Whether the drawings show a flow channel 12 extending along an outer surface of the fluid diverter member 4

Issue 2 – Whether Claims 3 and 8-10 contain structure that is not shown in the drawings

Issue 3 – Whether Claims 3 and 8-10 contain subject matter that is not described in the specification

Issues 1-3 are closely intertwined because in these three issues, the Examiner uses applicant's drawings as the basis for rejecting claims 3 and 8-10 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make or use the invention. On multiple occasions, applicant has stated his position that the drawings, as well as the written specification, clearly show and describe the claimed features. (See e.g. Exhibit D). Because issues 1-3 involve substantive issues on which claims have been rejected, it appears that these issues should be reviewed by the Board.

To make the situation even more confusing, the issues raised in issues 1-3 of applicant's appeal brief appear to have been resolved in applicant's favor by the Commissioner's November 18, 2003 decision in this case, in which the Commissioner ordered that the drawings be entered and that withdrawn claims be restored for consideration. (Paper No. 12, attached hereto as Exhibit C). The Commissioner's decision appears on its face to resolve any substantive issues concerning whether the

drawings do or do not show the features of the claimed invention. The Examiner has continued to take a different view, and in two subsequent office actions has rejected claims 3 and 8-10 on grounds that they contain structure that is not shown in the drawings. Applicant is of the view that the items are clearly shown in the drawings, and that the Commissioner reached the same conclusion in Paper No. 12. (Exhibit C).

At this point, applicant just hopes that this issue can be disposed of without further expenditures of his limited resources. This case has turned into a ping-pong match in which the applicant is being bounced back and forth between the Examiner, the Commissioner, and the Board of Patent Appeals and Interferences on issues that seem to have little or no relation to the substantive merits of the case. If the Commissioner believes that the foregoing issues are appropriate for petition, applicant respectfully requests that the Commissioner consider and resolve the issues, including consideration of the question of whether the issues were already disposed of in the Commissioner's decision in Paper No. 12. (Exhibit C) Otherwise, applicant requests that the issues be forwarded to the Board without further delay and expenditure of applicant's resources.

**Petition Issue 2: Whether applicant's status of claims statement complies with 37 CFR 1.192(c)(3)**

37 CFR 1.192(c)(3) provides that the brief must contain: "A statement of the status of all the claims, pending or cancelled, and identifying the claims appealed."

In the "Status of Claims" portion of his appeal brief applicant states: "Claims 1-10 are the subject of the appeal. No other claims are pending."

The Examiner takes the position that "In actuality, claims 1-17 are pending, claims 1-10 have been finally rejected and are the subject of this appeal, claims 11-17 have been withdrawn as being non-elected subject matter." The Examiner's position

raises form over substance. The "Status of Claims" portion of applicant's brief fully satisfies the requirements of 37 CFR 1.192(c)(3) and therefore should be accepted without further expenditures of applicant's resources.

**Petition Issue 3: Whether applicant's grouping of claims is acceptable**

In item 6 of the January 5, 2004 Notification of Non-Compliance, the Examiner concludes that applicant's grouping of claims is unacceptable for two reasons. The two reasons contradict each other, because on one hand the Examiner admits that applicant has stated that the claims do not stand or fall together, but on the other hand takes the position that applicant omits the statement. (Exhibit A) Petitioner seeks clarification and a determination as to whether he has complied with 37 CFR 1.192(c)(7).

In his statement concerning the grouping of claims, applicant used the following standard statement: "For each ground of rejection which appellant contests herein which applies to more than one claim, such additional claims, *to the extent separately identified and argued below*, do not stand or fall together." (Emphasis added; see Exhibit B). In his brief, applicant separate identifies and argues the allowability of certain of his claims. (Exhibit B, pp. 10-15).

37 CFR 1.192(c)(7) provides:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Applicant suggests that the Board is fully capable of applying applicant's standard statement of claim grouping and the principles embodied in 37 CFR 1.192(c)(7) in a

manner that complies with customary and everyday appeal practice. MPEP 1206 instructs the examiner that form paragraph 12.69.01 concerning defects in the grouping of claims “should be used only when no supporting reasons are presented in the brief.” (Emphasis original). Yet, in the Notification of Non-Compliance, the Examiner requires applicant to comply with the following elaborate procedure:

For each issue on appeal, identify whether the claims stand or fall together or do not stand or fall together. If claims do not stand or fall together, specifically identify, for each issue, which claims are grouped together as standing or falling together and which claims stand or fall by themselves. For each issue, appellant must provide a separate argument for each grouping stating why that grouping is separately patentable should the other groupings be deemed unpatentable.

Only one of the Examiner’s requirements is set forth in 37 CFR 1.192(c)(7), and applicant has met that requirement by including a statement concerning the grouping of claims. There is no practical reason to make applicant jump through hoops and hurdles in order to comply with arbitrary and subjective standards that are not required by the federal regulations that govern this situation. Even if applicant tried to comply with the Examiner’s labyrinth of requirements, it would be difficult to do so. The effort and resources consumed would be out of proportion with whatever assistance this exercise might provide to the Board, and applicant would risk receiving a further notification of noncompliance. Applicant therefore requests that his brief be deemed compliant with 37 CFR 1.192(c)(7). Alternatively, applicant requests clarification as to the Examiner’s conclusion that he has both included and not included a statement concerning the grouping of claims, along with directions as to how he can safely satisfy the Examiner’s requirements.

### **Conclusion**

Applicant's brief complies with the letter and spirit of 37 CFR 1.192. Applicant respectfully suggests that it is time to proceed forward to the Board and get the substantive issues of this case resolved without further delay and expenditure of applicant's resources.

If any fees are necessary, the Commissioner is authorized to charge them to Deposit Account 502346.

Respectfully submitted,



Shawn D. Sentilles, Reg. No. 38,299  
WYATT, TARRANT & COMBS, LLP  
1715 Aaron Brenner Drive, Suite 800  
Memphis, TN 38120-4367  
(901) 537-2192

Date: January 16, 2004



Exhibits

- A - January 5, 2004 Notification of Noncompliance (Paper No. 21)
- B - October 20, 2003 appeal brief
- C - November 18, 2002 decision on petition (Paper No. 12)
- D - November 4, 2002 petition to commissioner

# **EXHIBIT A**



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,328	11/19/2001	Bryan Bergeron	8100.01	6056

7590 01/05/2004

Shawn D. Sentilles, Esq.  
WYATT, TARRANT & COMBS, LLP  
1715 AARON BRENNER DRIVE  
SUITE 800  
MEMPHIS, TN 38120-4367

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>RECEIVED</b> Wyatt, Tarrant & Combs 8100.01 JAN 08 2004  Docketed by _____ Client No. 311436 Matter No. 000001
--

**Notification of Non-Compliance  
With 37 CFR 1.192(c)**

Application No.

09/992,328

Applicant(s)

BERGERON, BRYAN

Examiner

Stephen J. Castellano

Art Unit

3727

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

The Appeal Brief filed on 20 October 2003 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☒ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☒ A single ground of rejection has been applied to two or more claims in this application, and
  - (a) ☒ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
  - (b) ☒ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet

  
Stephen J. Castellano  
Primary Examiner  
Art Unit: 3727

Continuation of 9. Other (including any explanation in support of the above items): Item 2: Appellant states that claims 1-10 are the subject of the appeal and that no other claims are pending. In actuality, claims 1-17 are pending, claims 1-10 have been finally rejected and are the subject of this appeal, claims 11-17 have been withdrawn as being non-elected subject matter.

Item 6: In the Grouping section, appellant states: "For each ground of rejection which appellant contests herein which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand and fall together." This statement doesn't specifically state whether any claims stand or fall together or whether each claim stands and falls by itself. Therefore, item 6a has been marked. Also, since this statement implies that there is at least one claim which stands and falls by itself and the at least one claim is not separately argued, item 6b has been marked.

For each issue on appeal, identify whether the claims stand or fall together or do not stand or fall together. If claims do not stand or fall together, specifically identify, for each issue, which claims are grouped together as standing or falling together and which claims stand or fall by themselves. For each issue, appellant must provide a separate argument for each grouping stating why that grouping is separately patentable should the other groupings be deemed unpatentable:

Item 9: Issues 1-3 pertain to petitionable matters rather than appealable matters and should not appear in an appeal brief.

## **EXHIBIT B**

DOCKET NO.:

IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

In re Application of: Bryan Bergeron

Serial No.: 9/992,328

Filed: November 19, 2001

For: DRINKING CONTAINER

Group Art Unit: 3727

Examiner: Stephen J. Castellano

**Brief on Appeal**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**Real Party In Interest**

The party named in the caption of the brief, Bryan Bergeron, is the real party in interest.

**Related Appeals and Interferences**

Appellant knows of no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**Status of Claims**

Claims 1-10 are the subject of the appeal. No other claims are pending.

**Status of Amendments**

In a September 3, 2003 response to the final office action, appellant requested an amendment of Claim 8 to provide an antecedent basis for the first mention of "outer surface" in

order to place claim 8 in better form for appeal. Appellant also requested entry and review of new claims 18-22, which presented somewhat narrower versions of claims 3-7. In a September 12, 2003 advisory action, the Examiner declined to enter the proposed amendments.

### **Summary of Invention**

The invention is a drinking container for assisting a disabled person in drinking a fluid by reducing the degree of tilt necessary to drain the fluid from the container into the person's mouth. The invention differs from the prior art primarily in that it includes a fluid diverter member 4 and a flow channel 12 formed along the outer surface of the fluid diverter member 4.

Claim 1 is directed to a broad embodiment of the invention. Claim 1 includes a fluid holding vessel 2 having an upper rim 16 and a closed bottom 6, the upper rim having an opening through at least a sipping region 16A thereof, and a fluid diverter member 4 contiguous with an inner surface and the bottom of the vessel. As shown in Figures 1-4, the fluid diverter member 4 slopes downward substantially from the sipping region 16A of the rim 16 toward an opposing side of the vessel 2 such that when the bottom of the vessel is pivoted upward about the sipping region 16A of the rim 16, the fluid diverter member 4 compels fluid through the sipping region 16A. As will be discussed in further detail below, a detailed description of the fluid diverter member is provided at page 8, line 8 to page 9, line 2 of the original specification.

Independent claim 8 is directed to a narrower embodiment of the invention. As in claim 1, claim 8 includes a fluid holding vessel 2 having an open upper rim 16 and a closed bottom 6. Claim 8 further specifies that that the fluid holding vessel has an extension spout 8 extending upward and outward from the upper rim 16, an upper portion of the extension spout forming a



sipping region 16A. As in claim 1, claim 8 includes a fluid diverter member 4. Claim 8 further specifies that the fluid diverter member 4 is a wedge-shaped fluid diverter member 4 contiguous with an inner surface and the bottom of the vessel, the fluid diverter member 4 sloping downward from the sipping region 16A of the extension spout 8 toward an opposing side of the vessel 2 such that when the bottom of the vessel is pivoted upward about the sipping region 16A, the fluid diverter member 4 compels fluid through the sipping region. Claim 8 also includes a flow channel 12. The flow channel 12 extends lengthwise along the outer surface of the fluid diverter member 4, as shown in Figures 1C, 2B, and 3B. The flow channel 12 is positioned and configured to assist the fluid diverter member 4 in compelling fluid through the sipping region. As will be discussed in further detail below, a description of the flow channel 12 is provided at page 9, line 14 to page 10, line 5 of the original specification.

Claim 2 depends from claim 1 and further specifies that the fluid diverter member 4 is wedge shaped. Claim 3 depends from claim 1 and further specifies that the fluid diverter member 4 has a flow channel 12 extending lengthwise along an outer surface of the fluid diverter member 4, the flow channel 12 positioned and configured to assist the fluid diverter member 4 in compelling fluid through the sipping region 16A.

Claim 4 depends from claim 1 and further comprises a handle 18 on an outer surface of the vessel 2, the handle positioned at about ninety degrees relative to the sipping region 16A. Claim 9 adds the same handle limitation to independent claim 8.

Claim 5 depends from claim 1 and further comprises a pair of handles 22 on an outer surface of the vessel 2, one of the handles positioned at about 90 degrees relative to the sipping

region, and the other of the handles positioned at about 270 degrees relative to the sipping region, as shown in Figures 2A and 2B. Claim 10 adds the same handle limitations to independent claim 8.

Claim 6 depends from claim 1, and further specifies that the sipping region 16A comprises an extension spout 8 extending upward and outward from the upper rim 16, the extension spout 8 contiguous with the fluid diverter member 4 to thereby assist the fluid diverter member 4 in compelling fluid through the sipping region 16A, as shown in Figures 1A and 1B.

Claim 7 depends from claim 1 and further comprises a lid 20 configured to removably seal the upper rim 16, the lid 20 having an extension spout 8 configured to extend the fluid diverter member 4 upward and outward to thereby assist the fluid diverter member 4 in compelling fluid through the sipping region 16A, as shown in Figures 4A and 4B.

#### **Issues**

Issue 1 – Whether the drawings show a flow channel 12 extending along an outer surface of the fluid diverter member 4

Issue 2 – Whether Claims 3 and 8-10 contain structure that is not shown in the drawings

Issue 3 – Whether Claims 3 and 8-10 contain subject matter that is not described in the specification

Issue 4 – Whether Claims 1-10 are anticipated by Neville and Dixon

Issue 5 – Whether Claims 1-6 and 8-10 are anticipated by Watson

Issue 6 – Whether Claims 4, 5, 9 and 10 are obvious over Neville/Dixon in View of Rosen

## **Grouping of Claims**

For each ground of rejection which appellant contests herein which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

## **Argument**

The issues are presented in the order in which they appeared in the last two office actions. Appellant is of the view that the first two issues were resolved by the Commissioner's November 18, 2002 Decision on appellant's petition, in which the Commissioner ordered appellant's drawings to be entered. With regard to the remaining issues, appellant is of the view that his invention and claims are being misconstrued, particularly with regard to the meaning of "fluid diverter member" and "flow channel." Appellant is of the view that if these terms are construed consistently with appellant's specification and given weight in the patentability determinations, then the art cited by the Examiner clearly neither anticipates nor renders obvious the claimed invention.

### **Issue 1 – Whether the drawings show a flow channel 12 extending along an outer surface of the fluid diverter member 4**

The drawings are objected to as not showing a flow channel 12 extending along an outer surface of the fluid diverter member 4 as stated in claims 3 and 8. Appellant is of the view that the Commissioner's November 18, 2002 Decision on appellant's petition resolved any issues concerning the drawings, including this issue, which was specifically addressed in appellant's petition. The Commissioner concluded that appellant's drawings were acceptable and were to be entered.

Figures 1C, 2B and 3B show the flow channel 12 extending along an outer surface of the fluid diverter member 4. The following excerpt from pages 9-10 of appellant's application fully explains the features in question:

To enhance the flow of liquid from the container, a flow channel or groove 12 is preferably formed in the middle of the internal wedge, thus providing the liquid with a specific flow channel. The flow channel 12 is positioned and configured to assist the fluid diverter member 4 in compelling fluid through the sipping region 16A. As shown most clearly in Figure 1C, the flow channel 12 preferably extends lengthwise along an outer surface of the fluid diverter member 4. The channel is preferably continuous from the bottom 6 of the container 2 to the extension spout 8, in order to help prevent spillage as the container is emptied. In the preferred embodiment shown in Figure 1C, the flow channel comprises a lengthwise groove formed by a pair of curved walls 13A, 13B.

(Original specification page 9, line 14 to page 10, line 5).

The examiner has taken the position that the drawing objection can be resolved by changing the word "outer" in line 2 of claim 3 to "inner" or "upper" and by changing the word "outer" in line 12 of claim 8 to "inner" or "upper." (Page 3) Appellant has declined to make the change. As explained in further detail with regard to Issue 2, there is a very good reason why appellant has chosen to call the area in question an "outer" surface, rather than an "inner" or "upper" surface.

The examiner's proposed change in claim terminology is immaterial to whether the drawings show the claimed subject matter. There is no question whatsoever that the drawings clearly and unambiguously show a flow channel 12 extending along an outer surface of the fluid diverter member 4. Appellant's petition on this issue has been granted by the Commissioner, and it is accordingly respectfully suggested that it should no longer be raised as a ground of objection.

## **Issue 2 – Whether Claims 3 and 8-10 contain structure that is not shown in the drawings**

Claims 3 and 8-10 are objected to as reciting structure pertaining to the flow channel 12 extending along an outer surface of the fluid diverter member 4, which the Examiner states has not been shown in the drawings. As with Issue 1, the grounds of this objection were disposed of by the Commissioner's November 18, 2002 Decision on appellant's petition.

As with the objection to the drawings, the examiner has taken the position the objection to claims 3 and 8-10 can be resolved by changing the word "outer" in line 2 of claim 3 to "inner" or "upper" and by changing the word "outer" in line 12 of claim 8 to "inner" or "upper." Appellant has declined to make the change because the Examiner's proposed amendment is unnecessary, does not add clarity, and would do little except give rise to potential issues under the *Festo* decisions.

Appellant is free to be his own "lexicographer." There is a reason why appellant has used the word "outer," as can be seen from the following excerpt from Page 9 of appellant's specification:

As shown in Figure 1A, the vessel 2 includes a fluid diverter member 4 disposed generally along one side of the container 2. The fluid diverter member 4 is contiguous with an inner surface and the bottom 6 of the vessel 2, such that fluid cannot seep behind the fluid diverter member 4. The diverter member 4 slopes downward substantially from the sipping region 16A of the rim toward an opposing side of the vessel such that when the bottom 6 of the vessel 2 is pivoted upward about the sipping region 16A of the rim 16, the diverter member 4 compels fluid through the sipping region 16A, and into the mouth of a user. As shown in the side view of Figure 1A, the fluid diverter member 4 is preferably wedge shaped. Because of the fluid diverter member 4, the cup or container 2 will empty with a minimal tilting angle. This internal wedge 4 forces all liquid in the container against the opposing wall of the container 2. The wedge member 4 can also be provided in the form of a preformed insert that is sized to fit into an existing drinking container, such as a conventional coffee cup or mug.

(Original specification, page 8, line 8 to page 9, line 2). This paragraph describes the fluid diverter members 4 as a generally wedge shaped member that is disposed inside of a drinking vessel such as a cup. Obviously, by the way the fluid diverter member 4 is described above (including but not limited to the way the fluid diverter member 4 is described with reference to the drawings), the fluid diverter member 4 has only one surface that is exposed; this exposed surface is the “outer” surface. The outer surface is exposed inside of the cup and serves, when the cup is pivoted upward about the sipping region, to compel liquid in the cup through the sipping region and into the mouth of a user. All of this is made clear by the foregoing excerpt from appellant’s specification. However, if there is any doubt as to the location of the “outer” surface, it is laid to rest by the following paragraph from appellant’s specification, which clearly and unambiguously explains how a flow channel 12 positioned on the outer surface of the fluid diverter member 4 can enhance the function of the fluid diverter member 4:

To enhance the flow of liquid from the container, a flow channel or groove 12 is preferably formed in the middle of the internal wedge, thus providing the liquid with a specific flow channel. The flow channel 12 is positioned and configured to assist the fluid diverter member 4 in compelling fluid through the sipping region 16A. As shown most clearly in Figure 1C, the flow channel 12 preferably extends lengthwise along an outer surface of the fluid diverter member 4. The channel is preferably continuous from the bottom 6 of the container 2 to the extension spout 8, in order to help prevent spillage as the container is emptied. In the preferred embodiment shown in Figure 1C, the flow channel comprises a lengthwise groove formed by a pair of curved walls 13A, 13B.

(Original specification, page 9, line 14 to page 10, line 5). As can be clearly seen from the foregoing description and accompanying drawings, the fluid diverter member 4 has one exposed surface or side, namely the “outer” surface. In a preferred embodiment, a flow channel or groove

12 is formed on this outer surface. A person of skill in the art, upon reading the specification and looking at the drawings, will understand that the claimed features are shown in the drawings.

Only by ignoring the specification and drawings can it be said that structure pertaining to the flow channel 12 extending along an outer surface of the fluid diverter member 4 is not shown in the drawings. For the foregoing reasons, the claimed feature of a flow channel 12 extending along an outer surface of a fluid diverter member 4 is clearly and unambiguously shown in the drawings. Appellant's petition on this issue has been granted by the Commissioner, and it is accordingly respectfully suggested that it should no longer be raised as a ground of objection.

**Issue 3 – Whether Claims 3 and 8-10 contain subject matter that is not described in the specification**

Claims 3 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make or use the invention. In particular, the examiner takes the position that the only flow channels designated in the specification by reference number 12 are substantially inner upper surfaces. As with the foregoing claim and drawing objections, the examiner takes the position that the claim rejection under § 112 can be resolved by changing the word “outer” in line 2 of claim 3 to “inner” or “upper” and by changing the word “outer” in line 12 of claim 8 to “inner” or “upper.” (Page 3). For the reasons set forth below, appellant has declined to make the amendment.

The Examiner bears the burden of showing that the proposed claim language is indefinite to one of skill in the art. The Examiner has not met this burden, and has not even attempted to do so, other than to suggest that appellant change the word “outer” to “inner” or “upper” in the

rejected claims. However, changing the word “outer” to “inner” or “upper” is not going to make claims 3 and 8-10 any more clear than they already are. The law is clear that if the claims, read in light of the specification, reasonably apprise those skilled in the art of the use and scope of the invention, and if the language is as precise as the subject matter permits, the claims are definite under § 112, ¶ 2. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985). For the reasons discussed above, there is no question that a person of skill in the art, upon reading appellant’s claims in view of the specification, will understand exactly what appellant is claiming.

#### **Issue 4 – Whether Claims 1-10 are anticipated by Neville and Dixon**

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Neville and Dixon, Sr. et al. (“Dixon”).

Anticipation under 35 USC 102(b) requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 USPQ.2d 1286, 1291 (Fed.Cir.2001); MPEP § 2131. To establish a prima facie case of anticipation under 35 USC 102(b), the Examiner must identify the elements of the claims of the application, determine their meaning in light of the specification and prosecution history, and identify the corresponding elements disclosed in the allegedly anticipating references. *Lindermann Maschinenfabrick GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). If the Examiner does not produce a prima facie case of anticipation, then the appellant is entitled to the grant of a patent. *In re Oetiker*, 24 USPQ.2d 1443 (Fed. Cir. 1992).



Neither Neville nor Dixon disclose each and every element of the claimed invention. Among other things, Neville and Dixon completely fail to disclose the claimed fluid diverter member 4. Neville and Dixon each disclose only an ordinary drinking vessel having inwardly sloping walls. Only by ignoring appellant's specification (see e.g. page 8, line 8 to page 9, line 2) and drawings (Figures 1A, 1C, 2B, 3A, 3B, 4A), while simultaneously reading the teachings from appellant's specification and drawings into the cited references, can the inwardly sloping walls of Neville and Dixon somehow be construed as disclosing the claimed "fluid diverter member."

A §102(b) reference must place the needed subject matter supporting the anticipation rejection in the public domain. *In re Zenitz*, 333 F.2d 924, 142 USPA 158, 160 (CCPA 1964). The §102(b) reference must be such that a person of ordinary skill in the field of the invention would consider there to be no difference between the claimed invention and the reference disclosure. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ.2d 1001, 1010 (Fed. Cir. 1991). In other words, the §102(b) reference must put the claimed invention in the hand of one skilled in the art. *In re Spada*, 911 F.2d 705, 708, 15 UAPQ.2d 1655, 1657 (Fed. Cir. 1990; *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). The description from the §102(b) reference must enable a person with ordinary skill in the art not only to comprehend the invention but also to make it. *Paperless Accounting, Inc. v. Bay Area Rapid Transit System*, 804 F.2d 659, 665 (Fed. Cir. 1986), cert. den. 480 U.S. 933 (1987).

The Neville and Dixon references do not place the claimed invention in the hands of a person of ordinary skill in the art. The Neville and Dixon references make absolutely no reference to a drinking vessel having a structure therein for compelling fluid through a drinking area. All the references show is a drinking vessel having walls that uniformly slope inward. In Figures 1A, 1C, 2B, 3A, 3B, and 4A and pages 8-10 of his application, appellant describes in great detail a fluid diverter member 4 that differs markedly from a drinking container having inwardly sloping walls. The fact that appellant has included broad claims to a fluid diverter member should not prevent him from obtaining issuance of such claims, particularly when a fluid diverter member is not even found in the prior art. Appellant is entitled to have his claims interpreted in light of the description set forth in appellant's specification and drawings, not in a vacuum based on improper hindsight reconstruction of the invention.

Because neither Neville nor Dixon discloses each and every element of the claimed invention, it is respectfully submitted that a prima facie case of anticipation by Neville or Dixon has not been established.

#### **Issue 5 – Whether Claims 1-6 and 8-10 are anticipated by Watson**

Claims 1-6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Watson. Appellant respectfully submits that Watson does not anticipate claims 1-6 and 8-10. Watson differs markedly from the present invention because it does not disclose several features of the claimed invention. Because Watson does not disclose each and every element of the claimed invention, arranged as in the claims, it is respectfully submitted that the Examiner has not established a prima facie case of anticipation under 35 USC 102(b).

Independent claims 1 and 8 recite a “fluid diverter member contiguous with an inner surface and said bottom of said vessel, said diverter member sloping downward...from said sipping region...toward an opposing side of said vessel such that when said bottom of said vessel is pivoted upward about said sipping region...said diverter member compels fluid through said sipping region.” Claims 2, 4 and 6, which are dependent on claim 1, and claim 9, which is dependent on claim 8, also include the fluid diverter member recited in their corresponding independent claims. None of these claimed features are shown in the Watson reference.

The Examiner has not identified any of the elements of the claims of the application, particularly the fluid diverter member, or the corresponding elements disclosed in the cited anticipating reference. Accordingly, the absence of a fluid diverter member in Watson is sufficient to overcome the grounds for the 102(b) rejection.

Moreover, Watson relates to a drinking vessel comprising a spout that projects laterally from one side of the vessel near its open upper end. Both Watson’s disclosure and claims expressly recite a vessel comprising “a main body of generally hollow form having a closed bottom end, a generally uninterrupted peripheral side wall formed about a generally centered vertical axis, and terminating in an upper end.” This description of the main body of Watson’s vessel necessarily prohibits the inclusion of a fluid diverter member sloping downward from the sipping region toward an opposing side of the vessel.

For these reasons, the appellant submits that a prima facie case of anticipation has not been established as to claims 1-6 and 8-10 and it is respectfully suggested that the claims are allowable over the art of record.

## **Issue 6 – Whether Claims 4, 5, 9 and 10 are obvious over Neville/Dixon in View of Rosen**

Claims 4, 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville or Dixon in view of Rosen.

The Examiner bears the initial burden of factually supporting a prima facie conclusion of obviousness. MPEP § 2142. If the Examiner does not produce a prima facie case, the appellant is under no obligation to submit evidence of nonobviousness. *Id.* To establish a prima facie case of obviousness, the examiner must demonstrate: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings; (2) a reasonable expectation of success; and (3) that the references teach or suggest all of the claim limitations. *Id.*

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Appellant suggests that the Examiner has not made a prima facie case as to claims 4, 5, 9 and 10 because neither Neville nor Dixon in combination with Rosen teaches or suggests all the claim limitations, including without limitation a fluid diverter member.

The lack of a fluid diverter member in Neville and Dixon was discussed *supra*. Rosen relates to a leak resistant drink box holder, which by necessity includes a straw to evacuate the contents of the drink box. A fluid diverter member as claimed in the application would serve no purpose in the invention disclosed in Rosen for two reasons. First, Rosen's drink box holder does not hold fluid, but instead holds a solid drink box; therefore, there is no fluid in the vessel

that requires diverting. Second, since a straw is required to evacuate the contents of the drink box, pivoting the drink box holder would not result in the fluid diverter member compelling liquid through the sipping region, but instead would result in the failure of the straw to maintain a liquid seal and the inability to evacuate the drink box.

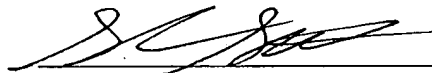
Based on the foregoing, the cited references not only fail to teach or suggest all of the claim limitations, namely the fluid diverter member, but also teach away from the inclusion of such a limitation in their respective inventions. Therefore, appellant submits that no prima facie case of obviousness has been established as to claims 4, 5, 9 and 10, and it is respectfully suggested that the claims are allowable over the art of record.

#### **Conclusion**

For the reasons advanced above, Appellant respectfully contends that each claim is patentable. Therefore, reversal of all rejections is courteously solicited.

To the extend necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502346 and please credit any excess fees to such deposit account.

Respectfully submitted,



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Date: October 20, 2003

Brief On Appeal  
Bryan Bergeron  
Ser. No. 9/992,328

## Appendix

1. A drinking container for assisting a disabled person in drinking a fluid by reducing the degree of tilt necessary to drain the fluid from the container into the person's mouth comprising:

a fluid holding vessel having an upper rim and a closed bottom, said upper rim having an opening through at least a sipping region thereof,

a fluid diverter member contiguous with an inner surface and said bottom of said vessel, said diverter member sloping downward substantially from said sipping region of said rim toward an opposing side of said vessel such that when said bottom of said vessel is pivoted upward about said sipping region of said rim, said diverter member compels fluid through said sipping region.

2. The drinking container of claim 1, wherein said fluid diverter member is wedge shaped.

3. The drinking container of claim 1, further comprising a flow channel extending lengthwise along an outer surface of said fluid diverter member, said flow channel positioned and configured to assist said fluid diverter member in compelling fluid through said sipping region.

4. The drinking container of claim 1, further comprising a handle on an outer surface of said vessel, said handle positioned at about ninety degrees relative to said sipping region.

5. The drinking container of claim 1, further comprising a pair of handles on an outer surface of said vessel, one of said handles positioned at about 90 degrees relative to said

sipping region, and the other of said handles positioned at about 270 degrees relative to said sipping region.

6. The drinking container of claim 1, wherein said sipping region comprises an extension spout extending upward and outward from said upper rim, said extension spout contiguous with said fluid diverter member to thereby assist said fluid diverter member in compelling fluid through said sipping region.

7. The drinking container of claim 1, further comprising a lid configured to removably seal said upper rim, said lid having an extension spout configured to extend said fluid diverter member upward and outward to thereby assist said fluid diverter member in compelling fluid through said sipping region.

8. A drinking container for assisting a disabled person in drinking a fluid by reducing the degree of tilt necessary to drain the fluid from the container into the person's mouth comprising:

a fluid holding vessel having an open upper rim and a closed bottom,

an extension spout extending upward and outward from said upper rim, an upper portion of said extension spout forming a sipping region,

a wedge-shaped fluid diverter member contiguous with an inner surface and said bottom of said vessel, said fluid diverter member sloping downward from said sipping region of said extension spout toward an opposing side of said vessel such that when said bottom of said vessel is pivoted upward about said sipping region, said diverter member compels fluid through said sipping region, and

a flow channel extending lengthwise along said outer surface of said fluid diverter member, said flow channel positioned and configured to assist said fluid diverter member in compelling fluid through said sipping region.

9. The drinking container of claim 8, further comprising a handle on an outer surface of said vessel, said handle positioned at about ninety degrees relative to said sipping region.

10. The drinking container of claim 8, further comprising a pair of handles on an outer surface of said vessel, one of said handles positioned at about 90 degrees relative to said sipping region, and the other of said handles positioned at about 270 degrees relative to said sipping region.





## **EXHIBIT C**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

NOV 18 2002

Paper No. 12

In re Application of

Bryan Bergeron

Application No. 09/992,328

Filed: November 19, 2001

Attorney Docket No. 7436-1

:  
: DECISION ON PETITION  
:

This is a decision on the petition filed on November 4, 2002 by which petitioner requests supervisory review of the examiner's final restriction requirement, and certain specific relief therefrom. In addition, petitioner requests relief from the examiner's refusal to enter proposed formal drawings as defining new matter. No fee is required for the petition, and a refund of the \$130.00 petition fee tendered with the petition will be scheduled.

The petition is granted-in-part.

In paper No. 3, the examiner promulgated a requirement that petitioner elect between claims 1-10, drawn to a drinking container and claims 11-17, drawn to a method of using a drink container. The examiner further required (presumably in the event of an election of the container claims), that petitioner elect between the species of "Group A" which was stated to comply with Figures 2A and 2B, and the species "Group B" of Figures 4A and 4B.

In paper No. 4, petitioner elected the claims drawn to the drinking container, and traversed the requirement to elect between the container claims and the method claims. Petitioner further elected the species of "Group A", noting that the election was "without traverse." Petitioner identified all of the container claims as "reading on" the elected species with the exception of claim 7.

In paper No. 5, the examiner, opined that Figures 2A and 2B "do not show a wedge shaped fluid diverter as claimed in claims 2 and 8-10, do not show a flow channel extending lengthwise along an outer surface of said fluid diverter member as claimed in claims 3 and 8-10 and do not show an extension spout as claimed in claims 6 and 8-10." The examiner accordingly held that claims 2, 3, 6 and 8-10 did not read on the elected species, and that only claims 1, 4 and 5 read on the elected species. The examiner proceeded to act only on claims 1, 4 and 5.

Petitioner argues that the requirement to elect between the container claims and the method claims was erroneous because petitioner disagrees with the examiner's holding that the drinking cup can be used as other than a drinking cup, and therefore, in a method other than the recited method of claims 11-17. Petitioner categorizes the examiner's example as removing meaning from the statutory requirements of 35 USC § 121. Petitioner further argues that the examiner has not provided reasons for insisting upon restriction as required by MPEP § 808.02.

A review of the requirements set forth in the relevant portions of Chapter 800 of the Manual of Patent Examining Procedure shows that the examiner's restriction requirement between claims 1-10 as drawn to a drinking container and claims 11-17 as drawn to a method of using that container to drink as performed by a "disabled user" is perfectly proper. It is clear that the drinking container, as claimed, can be used in a literal plethora of methods, some related to utility with fluids, others having nothing to do with fluids. An example of the former would

be one as provided by the examiner. Another example would be to use the container to water one's flower bed. An example of the latter would be to use the container to store items within. Petitioner is neglecting that as a general rule, a statement of intended use "drinking container for assisting a disabled person in drinking a fluid by reducing the degree of tilt necessary to drain the fluid from the container into the person's mouth" would not necessarily distinguish over a reference showing all of the positively recited structure following the word "comprising" in the claim. Such a reference might well render the structural claim unpatentable under 35 USC § 102, while failing to have anything at all to do with the patentability of the method of use claims. Office practice is very specifically discussed in MPEP § 806.05(e) and MPEP § 806.05(h), and whether petitioner chooses to categorize the invention of claims 1-10 as and apparatus for performing the process of claims 11-17, or as a product which performs the method of claims 11-17, it is clear that the examiner has demonstrated that patentability of the process (how the apparatus or product would be used) is a distinct matter from the issue of patentability of the apparatus (or product) *per se* in a manner which satisfies Office practice. Furthermore, petitioner's argument *vis-a-vis* failure to demonstrate a reason for insisting on restriction as required by MPEP § 808.02 is not understood. The examiner has indicated a separate classification for the method and the product (or apparatus); MPEP § 808.02 requires nothing more.

The examiner's holding that claims 2, 3, 6 and 8-10 do not read on Figures 2A and 2B is, however, another matter. The examiner is the one who said that there are two distinctly claimed species, that of Figures 2A and 2B, and that of Figures 4A and 4B. Yet original claims 2, 3, 6 and 8-10 were original claims. Therefore, it would seem that either there is a third species defined by those claims which the examiner neglected to list in the original restriction requirement, or those claims in fact read on Figures 2A and 2B; the only difference between the "species" of Figures 2A and 2B and the "species" of Figure 4 which is set forth in the disclosure and in the claims is the cap in Figure 4.

The conclusion is inescapable that the examiner's holding in which he withdrew claims 2, 3, 6 and 8-10 from consideration was erroneous; either the examiner failed to offer petitioner the opportunity to elect the species defined by those claims, or the examiner erred in holding that they are not part of the disclosure of the species of Figures 2A and 2B. In fact, it is clear that all of the claims in fact read on Figures 4A and 4B, since the container illustrated therein is in fact "the container" described with respect to the various Figure 2 drawings, and would therefore include the features shown therein and described in the written specification. In actuality, it appears to the undersigned that there aren't two species of invention in this application at all, but rather a combination including a drinking vessel and a cap, and a subcombination defined by the drinking vessel *per se*. And therefore, not only is it deemed proper to hold that claims 2, 3, 6 and 8-10 should have been examined in this application, but the claim 7 should likewise have been examined since the examiner has not convincingly established two way distinctness between claim 7 and claims 1-6 and 8-10.

As to the drawings, a review of the original disclosure and of the formal drawings appended to the petition is convincing that the formal drawings do not illustrate subject matter which was reasonably conveyed as having been in the possession of petitioner on the day that this application was filed. Therefore, the examiner's holding to the contrary is deemed to be clearly erroneous, and the formal drawings attached to the petition will be entered, subject to satisfaction of the formal drawing standards of 37 CFR 1.84.

Accordingly, the petition will be granted to the extent that:

- a. The election of species requirement will be withdrawn, and all of the pending product (or apparatus) claims will be examined.
- b. The formal drawings attached to the petition will be entered.

The petition is denied with respect to the examiner's requirement to restrict between claims 1-10 and claims 11-17, the latter being a method of using the device recited in claims 1-10. However, The application is being forwarded to the Head Supervisory Applications Examiner for:

- a. A refund of the \$130.00 petition fee.
- b. Entry of the Notice of Appeal filed on November 4, 2002 as paper No. 9
- c. Entry of the change of correspondence address as paper No. 11 (both the correspondence address and attorney docket number must be changed in the PALM system.)

Thereafter, the application will be forwarded to the Supervisory Patent Examiner of Art Unit 3727 who will insure that the next action in this application is not inconsistent with this decision.

PETITION GRANTED-IN-PART

  
E. Rollins-Cross, Director, Patent  
Examining Groups 3710 and 3720

Shawn D. Sentilles  
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1715 Aaron Brenner Drive  
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Memphis, TN 38120-4367

## **EXHIBIT D**

IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

APPLICANT: Bryan Bergeron

ATTY DOC#: 7436-1 (formerly 8100.01)

SERIAL No.: 09/992,328

ART UNIT: 3727

FILING DATE: November 19, 2001

EXAMINER: Stephen J. Castellano

TITLE: "Drinking Container"

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The Honorable Commissioner of  
Patents and Trademarks  
Washington D.C. 20231

**PETITION TO (1) WITHDRAW RESTRICTION REQUIREMENT; (2)  
REQUIRE REINSTATEMENT OF CLAIMS 2, 3, 6 AND 8-10 BASED ON THE  
SUFFICIENCY OF THE DRAWINGS; AND (3) WITHDRAW NEW MATTER  
REJECTIONS RELATED TO DRAWING AMENDMENTS AND TO REQUIRE  
ENTRY OF APPLICANT'S FORMAL DRAWINGS**

Dear Commissioner:

Applicant respectfully petitions the Commissioner to: (1) withdraw a restriction requirement, thereby returning claims 7 and 11-17 to the case; (2) require reinstatement of claims 2, 3, 6, and 8-10 based on the sufficiency of the drawings; and (3) withdraw new matter rejections related to applicant's drawings and to require entry of applicant's formal drawings.

This application covers a simple drinking container that has no moving parts. The application originally contained 17 claims, but through the assertion of several unusual and overly technical objections, the Patent Office has limited examination of this

application to only claims 1, 4, and 5. For the following reasons, withdrawal of the restriction requirement and the objections is respectfully requested.

**1. Petition to Withdraw Restriction Requirement**

The Patent Office required restriction on the basis that the application contains claims to Invention I (claims 1-10, drawn to a drinking container) and Invention II (claims 11-17, drawn to methods of using the drinking container claimed in claims 1-10). The Examiner also indicated that the application contains claims to two patentably distinct species, namely Group A (Fig. 2A and 2B), on which generic claim 1 and species claims 2-6, 8-10 read, and Group B (Fig. 4A and 4B), on which generic claim 1 and species claim 7 read. The Examiner's reason as to why the apparatus and method claims are independent and distinct inventions was simply that "the drinking cup can be used in a material different process of holding pencils." (February 19, 2002 Office Action, p. 2).

Applicant provisionally elected the invention of claims 1-10 (Invention I) with traverse, and requested reconsideration and withdrawal of the restriction requirement between claims 1-10 and 11-17 (i.e. Inventions I and II). The applicant also provisionally elected the species of Group A, on which generic claim 1 and species claims 2-6, 8-10 read. The election of species was made without traverse.

In the August 5, 2002 final office action, the examiner entered a final restriction requirement concerning claims 7 and 11-17. Applicant requests reconsideration and withdrawal of the restriction requirement because the Examiner has not made a prima facie showing that Invention I (apparatus; claims 1-10) and invention II (method of using the apparatus of invention I; claims 11-17), as claimed, are independent and distinct. Additionally, the restriction as to claim 7 should be withdrawn because claim 7 was never

subject to a restriction requirement. Claim 7 was subject to an election requirement, and should remain in the case because it depends directly from generic claim 1.

In order to meet its burden of establishing a prima facie basis for restriction, the Patent Office must provide (1) reasons why the inventions as claimed are independent or distinct, MPEP 806; and (2) the reasons for insisting upon restriction between the inventions. MPEP 808. It is respectfully submitted that the Patent Office has not met its burden under either of these criteria.

**a) The Examiner has not made a prima facie showing that Inventions I and II are independent and distinct as claimed**

35 U.S.C. § 121 provides, "If two or more independent and distinct inventions are claimed in one application, the Commissioner *may* require the application to be restricted to one of the inventions." (emphasis added). The Patent Office interprets the term "independent" to mean that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect. MPEP 802.01. The Patent Office interprets "distinct" to mean that two or more inventions are (1) capable of separate manufacture, use or sale as claimed, and (2) patentable over each other. MPEP 802.01. Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction is never proper. MPEP 806.05; 808.02.

Invention I and Invention II are directly related because method claims 11-17 (Invention II) simply claim methods of using Invention I. For example, method claim 11 recites: "providing a drinking container according to *claim 1* . . ." Claims 12-17 simply add further structural limitations that are found in claims that depend from claim 1. The apparatus of claims 1-10 (invention I) and the methods of claims 11-17 (invention II) both provide a drinking container for assisting disabled persons in drinking fluids by reducing the degree of tilt necessary to drain the fluid from the container, thus permitting



consumption without requiring a user to tilt one's head. It is difficult to imagine how two claimed inventions could be more related. The Patent Office has provided no plausible reason why they are not.

The Examiner's reason for insisting on restriction consists of the following statement: "In the instant case, the drinking cup can be used in a materially different process of holding pencils." (February 19, 2002 Office Action, Paragraph 2). In making the restriction requirement final, the Examiner again stated: "the container which holds fluid is clearly capable of holding pencils without fluid . . ." (August 5, 2002 Office Action, p. 2). Surely much more than this cursory example is required in order to meet the Patent Office's prima facie burden under 35 U.S.C. § 121 of demonstrating that Inventions I and II are independent and distinct inventions. The Examiner's example does not cite material differences between Inventions I and II. The Examiner is neglecting to consider the invention as claimed, and appears to be importing additional properties (i.e. storage of solid materials) that are not even mentioned in applicant's patent application. If the Patent Office can restrict simply by asserting that applicant's apparatus can be used in a materially different process of holding pencils, then the statutory requirement of 35 U.S.C. § 121 has no meaning or force of law whatsoever.

**b) The Examiner has not provided reasons for insisting on restriction between Inventions I and II**

If the Patent Office contends that related inventions are distinct under the criteria of MPEP 806.05, the Patent Office must also explain why the distinct inventions must be restricted on the basis of (a) separate classification, (b) separate status in the art, or (c) a different field of search. MPEP 808.02. In the present case, the Examiner merely states that "[b]ecause these inventions are distinct ...and have acquired a separate status in the art as shown by there different classification, restriction for examination purposes as indicated are proper." (Paragraph 3 of the February 19, 2002 Office Action). This

statement does not address the criteria of MPEP 808.02, and does not provide the required explanation as to why the allegedly distinct inventions must be restricted.

Moreover, the Examiner has classified Invention II in class 604. (Paragraph 1 of the February 19, 2002 Office Action). Class 604 is defined as "Surgery," a class which has no relationship to the claimed drinking container of the invention. While class 604 does include subclass 78, "Drinking Cup," it would be necessary to search both classes for either Invention I or Invention II, assuming the classification is correct. Thus, there would not be an increased burden on the Patent Office if the restriction requirement were withdrawn. The statement that the inventions have acquired a separate status in the art is unsupportable because claims 11-17 merely claim methods for using the apparatus of claims 1-10. Accordingly, the search required for Invention I was the same as the search required for Invention II.

Additionally, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803. In this case, examination of Inventions I and II can clearly be made without serious burden on the examiner, because Invention II merely claims a process for using the apparatus of Invention I.

Because the Patent Office has not set forth reasons why Inventions I and II as claimed are independent or distinct and the reasons for insisting upon restriction, the Patent Office has not met its burden of establishing a prima facie basis for restriction. Accordingly, applicant requests withdrawal of the restriction requirement between Inventions I and II, and that examination proceed forward on claims 1-17.

**2. Petition To Require Reinstatement Of Claims 2, 3, 6, And 8-10 Based On The Sufficiency Of The Drawings**

In this application, the Patent Office has raised several unusual and overly technical objections to applicant's drawings. In the April 26, 2002 first office action, the Patent Office withdrew claims 2, 3, 6 and 8-10 on grounds that elements of these claims were not shown in applicant's original draft drawings. (Exhibit A). In response to the first office action, applicant specifically explained where the claimed elements were shown in the original draft drawings. Additionally, in an attempt to address the Patent Office's objections, applicant hired a professional patent draftsman and submitted formal drawings. (Exhibit B). In the August 5, 2002 final office action, the Patent Office maintained its withdrawal of claims 2, 3, 6 and 8-10 on grounds that claimed elements are not shown in the drawings. For the following reasons, the examiner's reasons for withdrawing claims 2, 3, 6 and 8-10 are unfounded.

Examiner's statement concerning applicant's drawings	Applicant's response
"The fluid diverter 4, flow channel 12 and spout 8 are all located on substantially the same surface and these elements have no specific delineation to separate these elements as shown in Fig 2B."	Patent drawings routinely include a main component (here, the fluid diverter 4) that has subcomponents formed thereon (here, the flow channel 12 and the spout 8). The relationship of these three components to one another is clearly described at page 9, line 16 – page 10, line 10 of the specification. Applicant does not understand the basis of this objection, nor how it would be possible to comply with it.
"The elected specie of Fig. 2A and 2B do not show a wedge shaped fluid diverter as claimed in claims 2 and 8-10 . . ."	<p>The wedge shaped configuration of the fluid diverter member is shown in the cross-section view of Figure 1A. See specification p. 8, lines 14-15; see also Figures 3A and 4A. The top view shown in Figure 2B includes a fluid diverter member 4 that is wedge shaped.</p> <p>If the examiner is taking the position that due to applicant's election, figures other than Figs. 2A and 2B cannot be relied upon as showing claimed features,</p>

	this is clearly incorrect. Applicant elected claims 1-10, not the species of Fig. 2A and 2B.
"the fluid diverter (4) is shown but an elevation cross-section is not shown to provide details of a wedge shape, . . ."	An elevation cross-section of the wedge shape is shown in Figure 1A, 3A, and 4A.
"[The drawings] do not show a flow channel extending lengthwise along an outer surface of said fluid diverter member as claimed in claims 3 and 8-10, . . ."	In Figures 1C, 2B, and 3B, the flow channel 12 is shown extending lengthwise along an outer surface of the fluid diverter member 4.
"a flow channel (12) is shown but it extends along an inner surface not an outer surface (the inner surface is contiguous with the fluid diverter (4)) . . ."	In the specification at page 9, line 19- page 10, line 2, applicant states, "As shown most clearly in Figure 1C, the flow channel 12 preferably extends lengthwise along an <i>outer</i> surface of the fluid diverter member 4." The applicant is free to be his own lexicographer, and in this case the applicant is simply using the word "outer surface" to refer to the outer surface of the fluid diverter 4 that is exposed on the inside of the cup. Applicant does not understand the significance of the examiner's comment that "the inner surface is contiguous with the fluid diverter (4)."
"do not show an extension spout extending upward and outward from the upper rim as claimed in claims 6 and 8-10 where the upper rim has an opening through at least a sipping region."	These items are clearly shown in Figures 1A, 1B, 1C, 2A, and 2B. The relationship and location of these items are described at page 10, lines 6-10: "The drinking container shown in Figure 1 includes an extension spout 8 extending upward and outward from the upper rim 16. The sipping region 16A is formed on the upper end of the extension spout 8. As shown in Figure 1, the extension spout 8 is contiguous with the fluid diverter member 4 to thereby assist the fluid diverter member 4 in compelling fluid through the sipping region 16A."
"The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the flow channel extending lengthwise along an outer surface of the fluid diverter member as stated in claims 3 and 8-10 must be shown or the feature(s) canceled from the claims."	For the reasons set forth above, the flow channel is clearly shown in the drawings.

Undersigned has never filed a petition concerning drawing amendments, preferring instead to submit amended drawings in compliance with the Examiner's requirements. However, for the reasons set forth above, applicant does not understand how he could amend his drawings in order to satisfy the requirements of the Examiner. If the Commissioner denies applicant's petition concerning drawing amendments, applicant would appreciate clear guidance as to acceptable drawing amendments so that applicant can be certain that any further investments in patent drawings will meet with acceptance by the Patent Office.

**3. Petition To Withdraw New Matter Rejections Related To Applicant's Drawings And Require Entry Of Applicant's Formal Drawings**

In the final office action of August 5, 2002, the Examiner objected to applicant's formal drawings on grounds that they add new matter. The Examiner required applicant to submit amended drawings. Exhibit A contains applicant's original draft drawings, while Exhibit B contains applicant's amended drawings.

The new matter rejections are improper and unsupportable. First, the drawing features which the Examiner identified as new matter are undeniably disclosed in applicant's original drawings and specification, for the reasons set forth in the following table. Second, the Examiner raises form over substance by basing the new matter objections on extremely minor and unimportant differences between the original and formal drawings. In each case, the alleged "new matter" has absolutely no applicability or pertinence to the claims of the application. Accordingly, the new matter rejections should be withdrawn and the Examiner should be ordered to enter applicant's formal drawings.

Examiner's statement	Applicant's response
"The original disclosure does not support	The handles shown in formal drawing

the showing of a different shaped handle as shown in Fig. 1A and 1B,” “	Figures 1A and 1B are not significantly different from the original draft drawing Figures 1A and 1C. Any differences are not patentable distinctions; they are merely minor design modifications that were made by the professional draftsman who applicant hired to prepare his formal drawings.
“a differently shaped bottom as shown in Fig. 1C,”	The bottom of the cup shown in formal drawing Figure 1C is not significantly different from the original draft drawing Figure 1C. Any differences are not patentable distinctions; they are merely minor changes in shape and proportion that were made by the professional draftsman who applicant hired to prepare his formal drawings.
“different creases as shown on the interior of the fluid diverter, flow channel and spout in Figure 2B and as shown on the exterior of Fig. 2A near spout 8, etc.”	<p>The items shown in applicant’s original draft drawings are not “creases.” They are representative markings that were intended to indicate the curvature or contour of the flow channel 12. The professional draftsman who prepared applicant’s formal drawings replaced the contour lines of the original drawing with stippling, a technique that is widely used to show contours in patent drawings.</p> <p>This curvature is clearly described in the specification at page 10, lines 4-5: “In the preferred embodiment shown in Figure 1C, the flow channel comprises a lengthwise groove formed by a pair of curved walls.”</p>

For the foregoing reasons, the modifications that the Examiner objects to do not constitute the addition of new matter. All of the features shown in the formal drawings were included in the original draft drawings and in the original specification. The changes are merely minor design modification or changes in drawing technique that were made by the draftsman who prepared the formal drawings. If all applicants were held to the standards that the present applicant is being held to, attempts to replace informal

drawings with formal drawings would become prohibitively expensive and unduly difficult, if not impossible. Rather than raise form over substance, applicant respectfully requests that the new matter rejections be withdrawn and that the formal drawings be entered.

**Conclusion and Relief Requested**

For the foregoing reasons, applicant respectfully petitions the Commissioner to:

- (1) withdraw a restriction requirement, thereby returning claims 7 and 11-17 to the case;
- (2) require reinstatement of claims 2, 3, 6, and 8-10 based on the sufficiency of the drawings; and (3) withdraw new matter rejections related to applicant's drawings and to require entry of applicant's formal drawings.

Respectfully submitted,



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Date: November 4, 2002

## **EXHIBIT A**



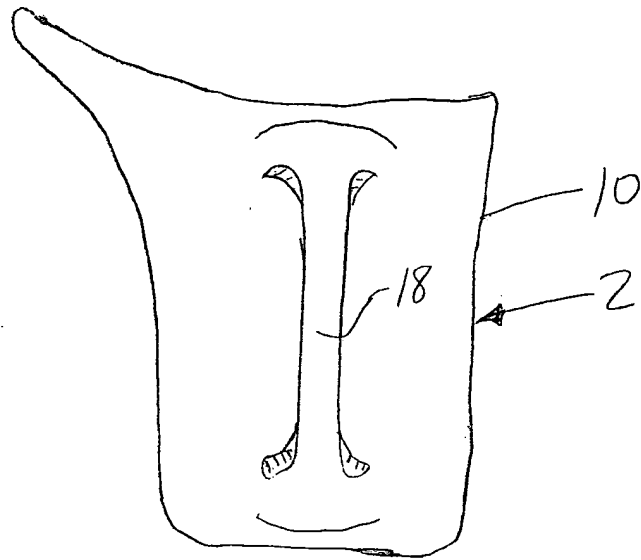


FIG. 1B

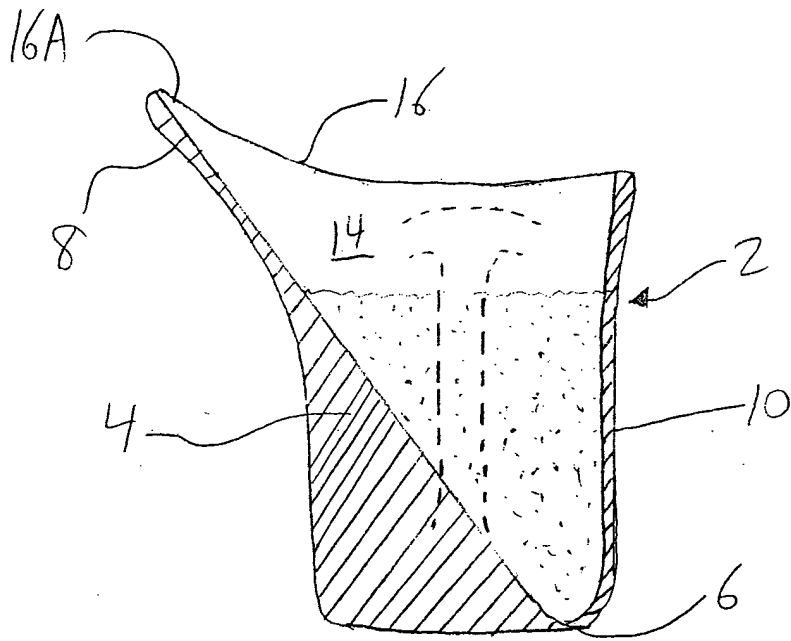


FIG. 1A

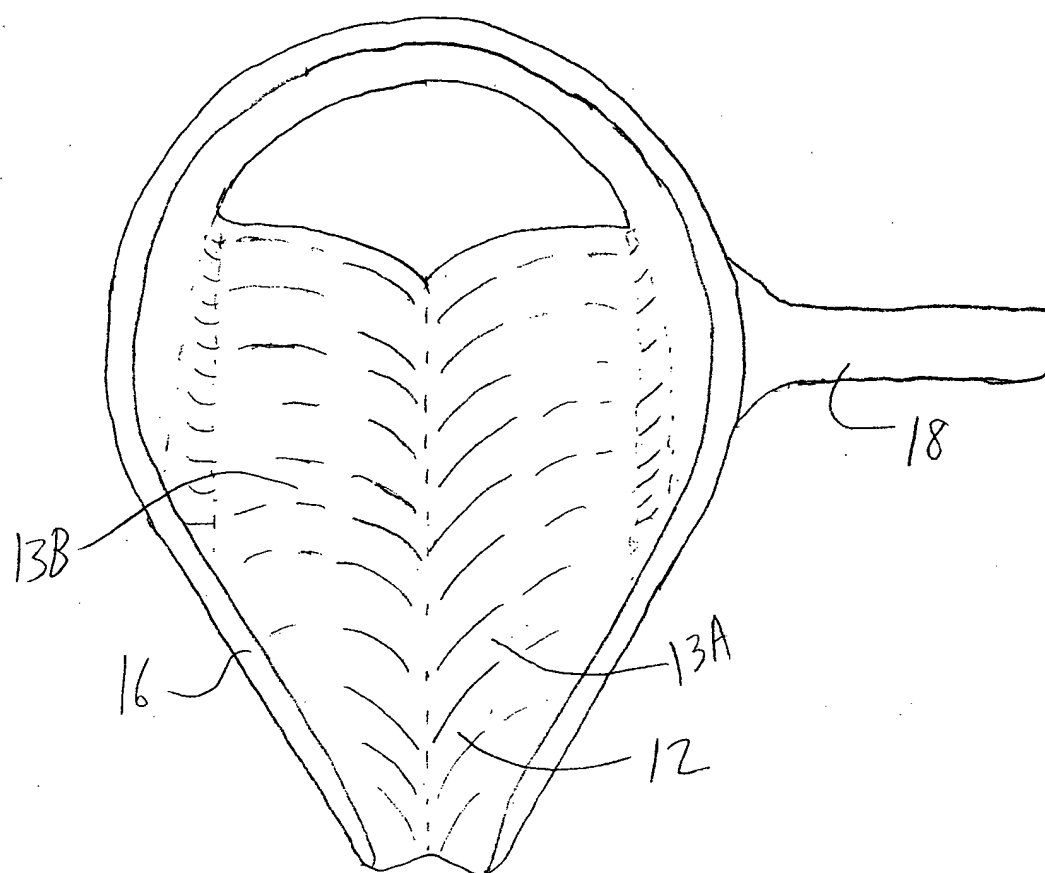


FIG. 1C

TOP VIEW

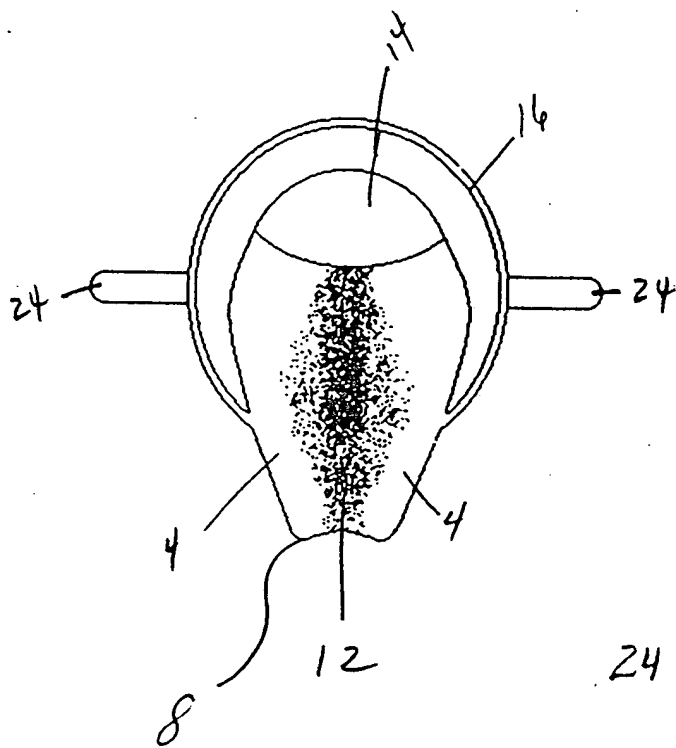


Fig. 2B

SIDE VIEW

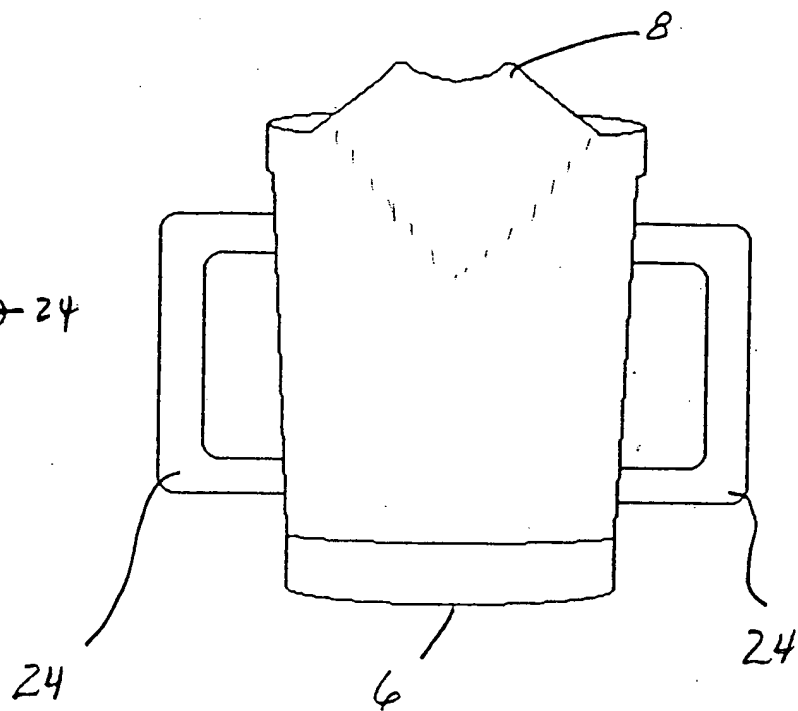


Fig. 2A

2

TOP VIEW

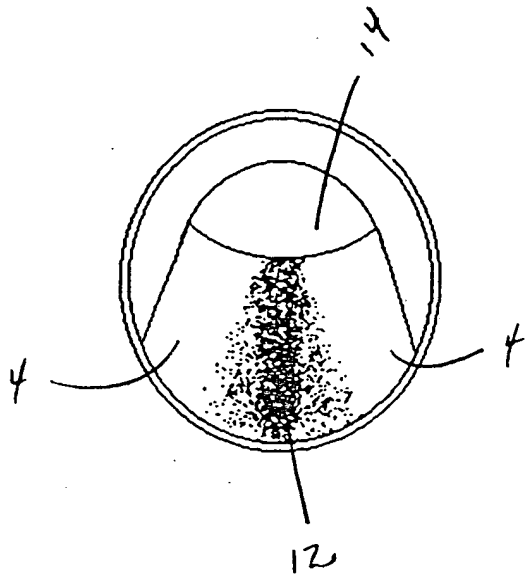


Fig 3B

SIDE VIEW

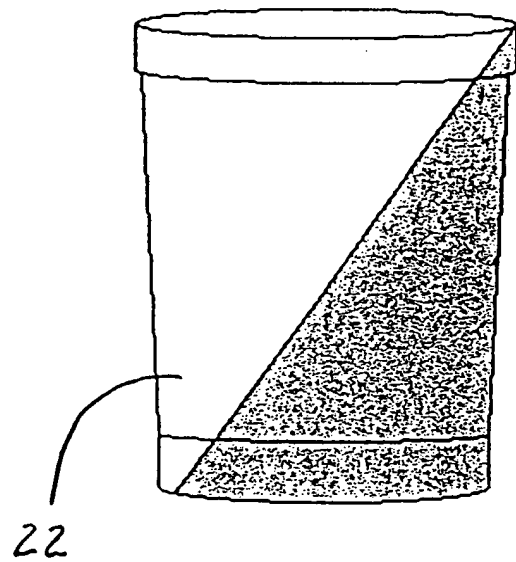


Fig 3A

2

TOP VIEW

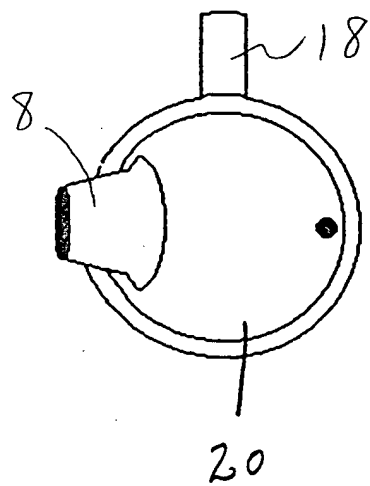


Fig. 4B

SIDE VIEW

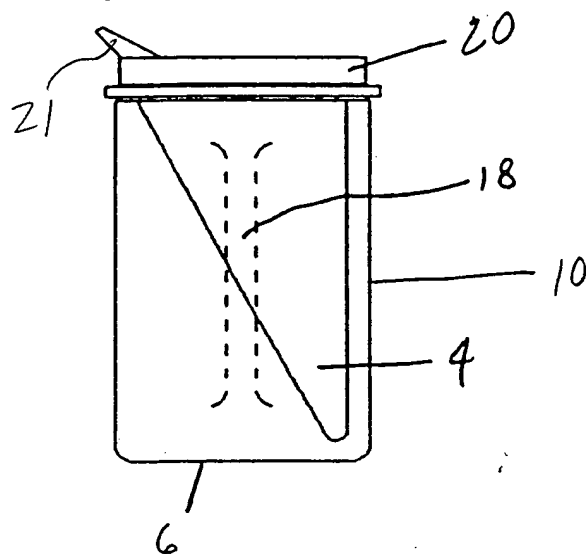


Fig. ~~5A~~ 4A

TOP VIEW

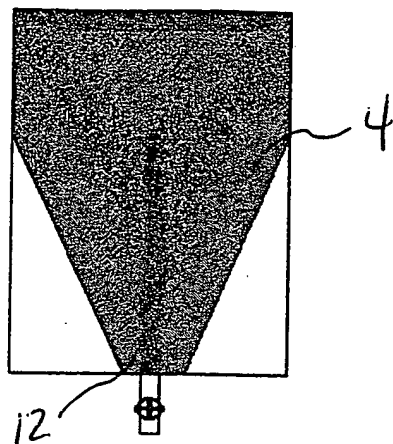


FIG. 6

SIDE VIEW

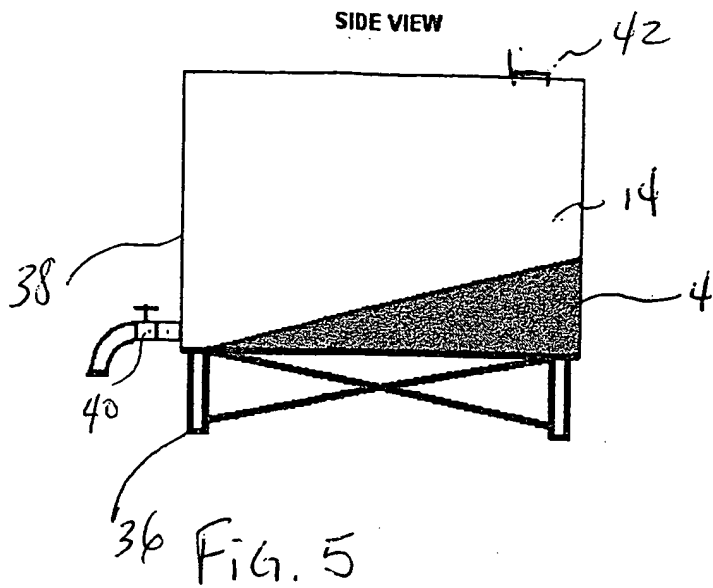


FIG. 5

## **EXHIBIT B**

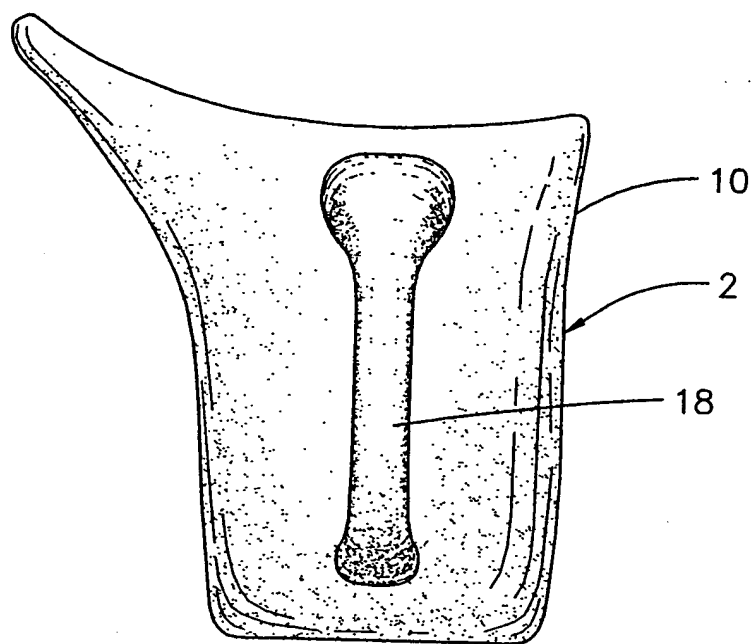


FIG. 1B

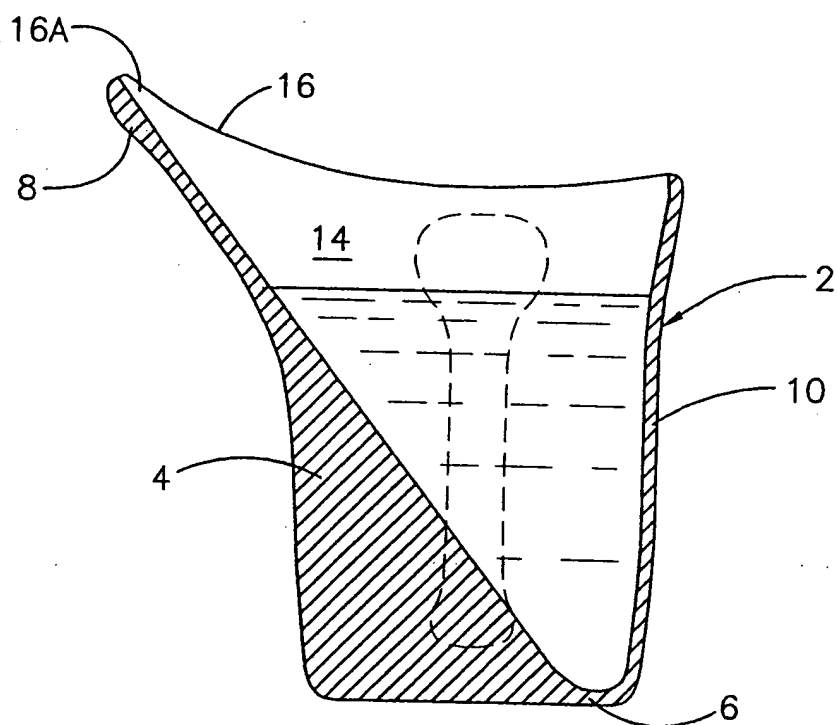


FIG. 1A



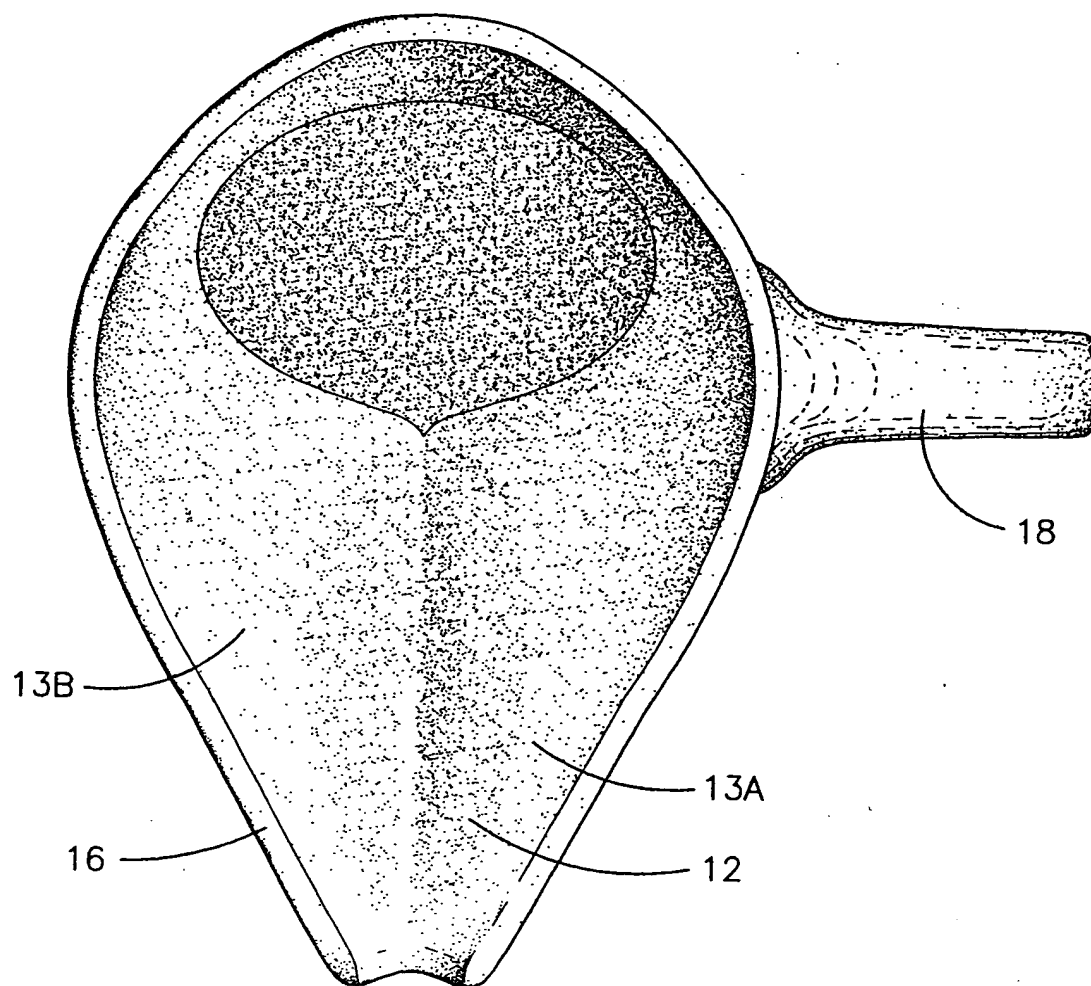


FIG. 1C

TOP VIEW

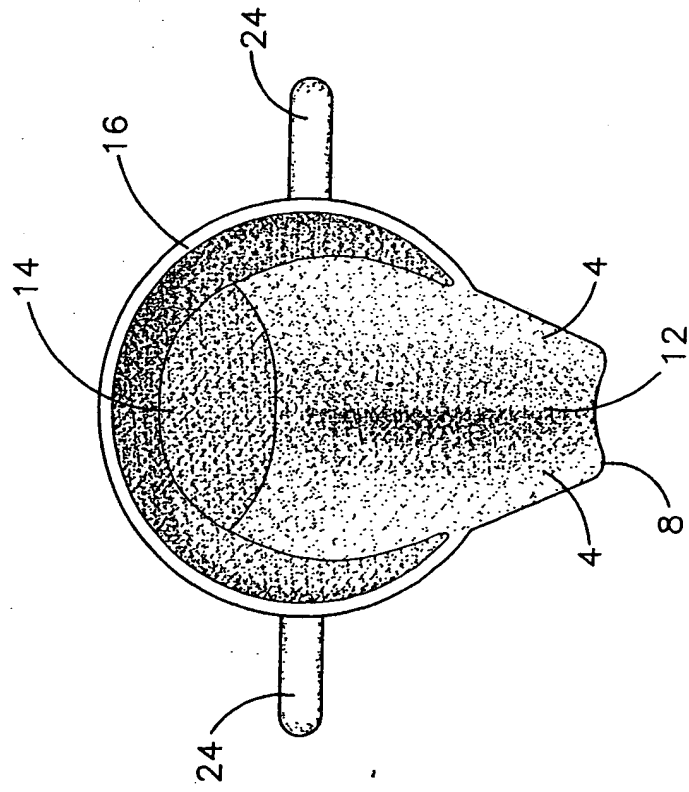


FIG. 2B

SIDE VIEW

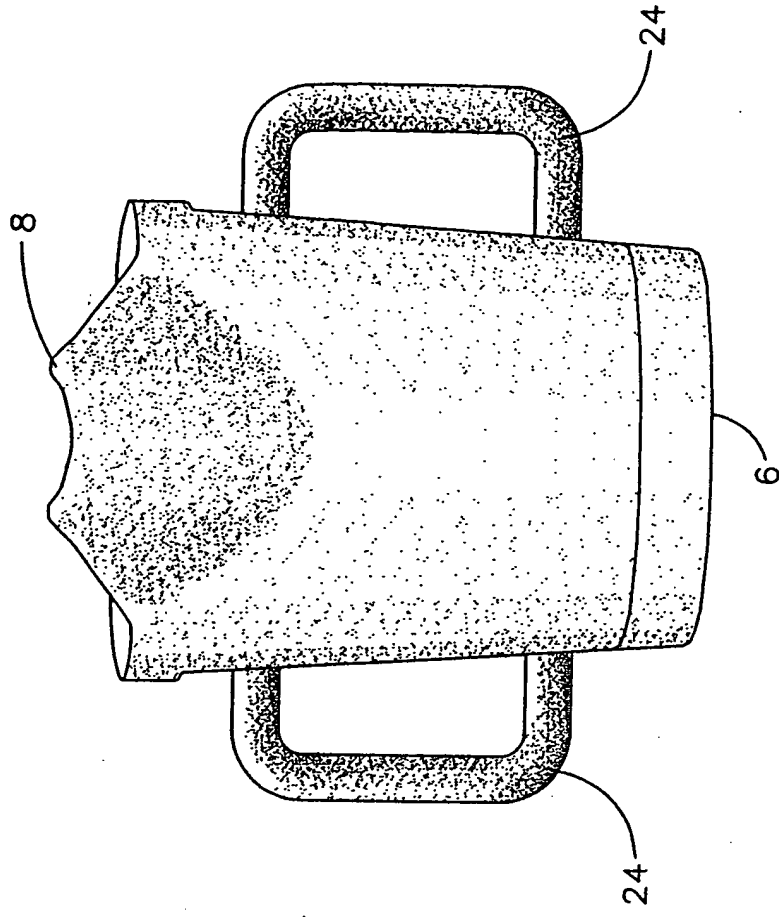


FIG. 2A

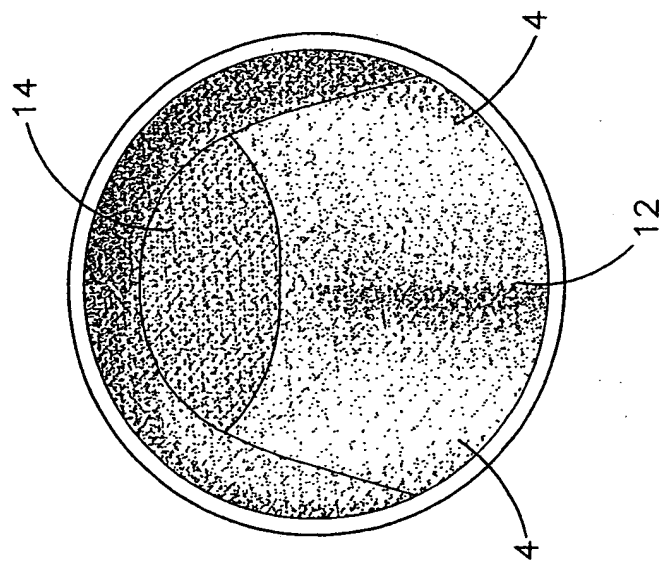


FIG. 3B

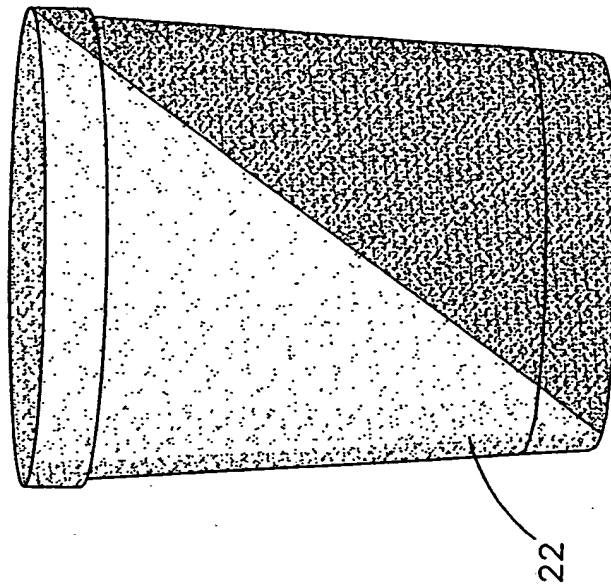


FIG. 3A

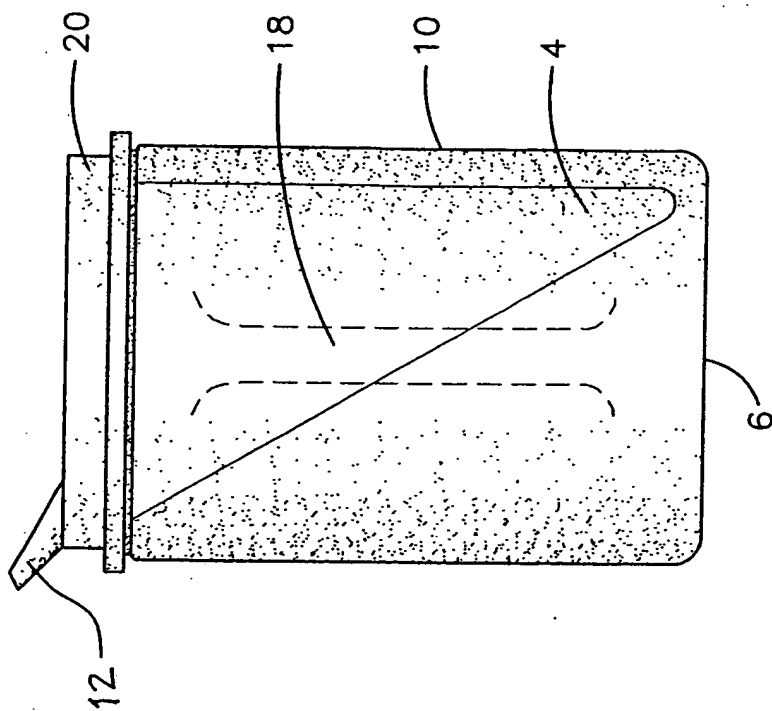


FIG. 4A

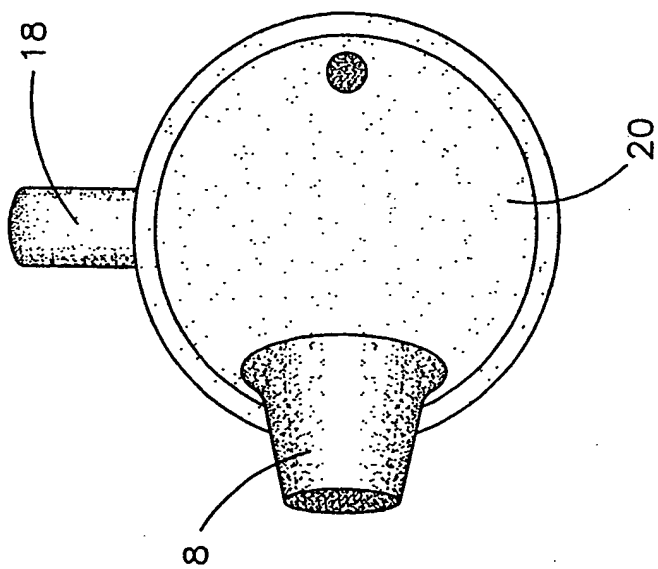


FIG. 4B

TOP VIEW

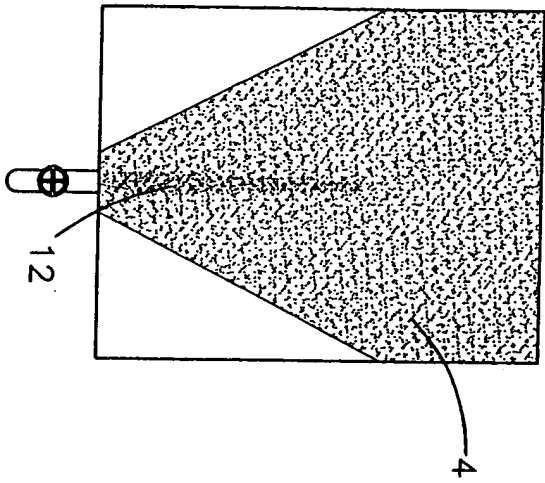


FIG. 6

SIDE VIEW

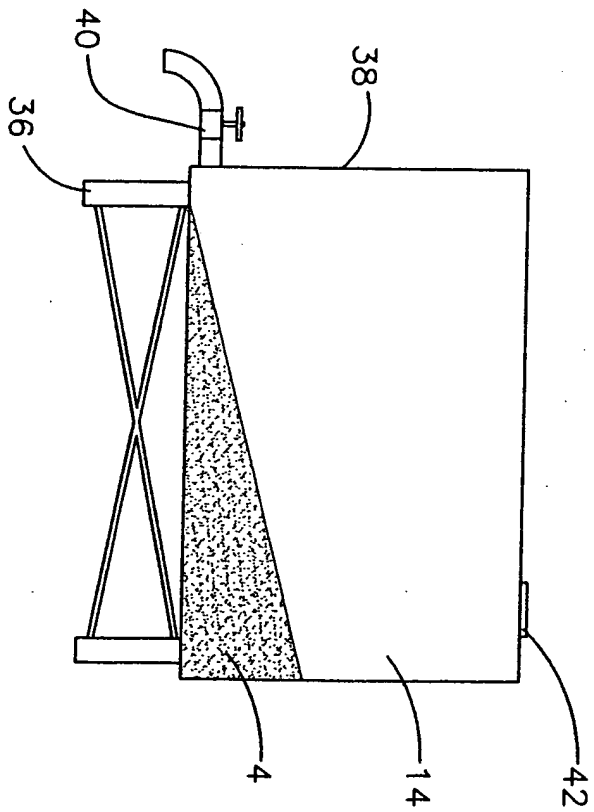


FIG. 5